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Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/172,193	10/13/98	MOSCOVITCH	J 5005-000001/ <i>Pz</i>

PM82/0120

EXAMINER

RAMIREZ, R

ART UNIT

PAPER NUMBER

3632

DATE MAILED:

*13*  
01/20/00

H KEITH MILLER  
HARNESS DICKEY & PIERCE  
5445 CORPORATE DR  
SUITE 400  
TROY MI 48098

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/172,193**

Applicant(s)  
**Moscovitch**

Examiner  
**RAMON O. RAMIREZ**

Group Art Unit  
**3632**



☒ Responsive to communication(s) filed on Dec 13, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-15, 17, and 18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-15, 17, and 18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

***Detailed Action***

This is the fourth Office Action corresponding to communication of Dec 13, 1999.

***Allowable Subject Matter***

The allowable subject matter indicated in the former Office Action is withdrawn in view of the rejection that follows.

***Defective Declaration***

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

the original declaration lacks the "original and first" statement as required by 37 CFR 1.63(b)(2), and that the original patent is "wholly (or partly) inoperative (or invalid)" as required by 37 CFR 1.175(a)(1).

A new Declaration including the above statements is required. Please be sure that the whole text of the Declaration is included.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) should be included in the response to this action.

An example of acceptable language to be used in the supplemental oath/declaration is as follows:

***"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."***

*Claim Rejections*

Claims 1-15, 17 and 18 are rejected as being based upon a defective reissue under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claims 17 and 18 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

A broadening aspect is present in the reissue which was not present in the application for the patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application cannot be recaptured by the filing of the present reissue application.

The limitation "a base" omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was the limitation "a base" which distinguished over the art of record.

Applicant did not present on the record a counter statement or comment as to the

examiner's reason for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered.

Claims 1-15, 17 and 18 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Declaration is set forth in the discussion above in this Office action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner **Ramírez** at telephone number (703) 308-0748. The examiner can be normally reached on Monday-Thursday from 6:30 AM - 4:00 PM. The examiner can also be reached on alternate Fridays from 6:30 through 3:00 PM.

The fax numbers for this Group are (703) 305-3597 (for formal papers), and (703) 308-3519 (for informal papers).


Any inquiry of general nature relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

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Art Unit: 3632

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A shortened statutory period for reply to this action is set to expire **THREE**  
**MONTHS** from the mailing date of this action.

R.O.RAMIREZ (19)  
January 19, 2000



RAMON O. RAMIREZ  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600  
ART UNIT 3632